

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Pierluigi Pugliese

Serial No.: 10/693,470

Filed: October 24, 2003

For: SYSTEM AND METHOD FOR COLLECTING DEBUGGING AND
SYSTEM CRASH INFORMATION FROM A MOBILE PHONE

Grp./A.U.: 2617

Examiner: Dai A. Phuong Confirmation No.: 2561

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop Appeal Brief-Patents

I hereby certify that this correspondence is being electronically filed with United States Patent and trademark Office on:

January 18, 2007 (Date)

Elizabeth Schumscher

(Printed or typed name of person signing the certificate)

/Elizabeth Schumscher/

(Signature of the person signing the certificate)

ATTENTION: Board of Patent Appeals and Interferences

Sirs:

APPEAL BRIEF UNDER 37 C.F.R. §41.37

This is an appeal from a Final Rejection dated November 11, 2006, of Claims 1-25. On November 7, 2006, Petitioner filed an Appeal Brief appealing a final rejection dated March 13, 2006. Citing new grounds for rejection, the Examiner reopened prosecution. Contemporaneously herewith, Appellant is filing a Notice of Appeal. There are no additional fees due with respect to the accompanying Notice of Appeal and this Appeal Brief. The previously paid \$500.00 fee for filing a

Notice of Appeal, as set forth in 37 C.F.R. §41.20(b)(1), and the previously paid \$500.00 fee for filing an Appeal Brief, as set forth in 37 C.F.R. §41.20(b)(2), are to be applied to the accompanying Notice of Appeal and to this Appeal Brief. Petitioner hereby authorizes the Commissioner to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 08-2395.

This Brief contains these items under the following headings, and in the order set forth below in accordance with 37 C.F.R. §41.37(c)(1):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. APPELLANT'S ARGUMENTS
- VIII. APPENDIX A - CLAIMS
- IX. APPENDIX B - EVIDENCE
- X. RELATED PROCEEDINGS APPENDIX

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is the Assignee, Agere Systems, Incorporated.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-25 are pending in this application and have been rejected under 35 U.S.C. §103(a). Each of the pending claims is being appealed.

IV. STATUS OF THE AMENDMENTS

The present Application was filed on October 24, 2003. In response to a first Examiner's Action mailed September 14, 2005, the Appellant filed a first Amendment on February 17, 2006. The Examiner entered the first Amendment and subsequently issued a Final Rejection on March 13, 2006. The Appellant then filed a Request for Reconsideration on May 12, 2006. In an Advisory Action mailed on June 30, 2006, the Examiner indicated that the Request for Reconsideration had been considered, but did not place the Application in condition for allowance. The Appellant filed a Notice of Appeal on June 26, 2006 and an Appeal Brief on September 7, 2006. In response to the Appeal Brief, the Examiner reopened prosecution and issued a Final Rejection dated November 13, 2006. Although a statement is made on page 7 of the Examiner's November 13, 2006 Final

Rejection, that the action was made final because the Appellant's amendment necessitated the new grounds for rejection, the Appellant did not submit an amendment subsequent to the first amendment on February 17, 2006. All the claims have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed, in general, to a mobile communication apparatus. The present invention introduces a method and apparatus for collecting data on a subscriber information module (SIM) card regarding at least one of the individual components and procedures embedded within a mobile communication apparatus and transmitting such data from the mobile communication apparatus to a service center via an affiliated radio network.

Independent Claim 1 is directed to a method of ascertaining a state of a mobile communication apparatus. In one embodiment, a SIM card is used to collect data on at least one of the individual components and procedures embedded within a mobile communication apparatus, based on status quo information derived therefrom, and transmitted by radio to a service center via a radio network with which the mobile communication apparatus is affiliated. (Paragraphs 0026; 0028 – 0031; FIGURE 1).

Independent Claim 13 is directed to a mobile communication apparatus. In one embodiment, a SIM card is used to collect data on at least one of the individual components and procedures embedded within the mobile communication apparatus, based on status quo information derived therefrom, and transmitted, using a means for radio transmitting, from the mobile communication apparatus via a radio network with which the mobile communication apparatus is affiliated, to a service center. (Paragraphs 0026; 0028 – 0031; FIGURES 1 and 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. The first issue presented for consideration in this appeal is whether Claims 1-6 and 10-25, as rejected by the Examiner, are patentably nonobvious under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 20010029263A1 filed by Xiang Zhang, in view of U.S. Patent Application Publication No. 20040042604A1 filed by Miska Hiltunen, *et al.* (Hiltunen).

2. The second issue presented for consideration in this appeal is whether Claims 7-9, as rejected by the Examiner, are patentably nonobvious under 35 U.S.C. §103(a) over Zhang, in view of Hiltunen, and further in view of U.S. Patent Application Publication No. 20040075675A1 filed by Tommi Raivisto, *et al.* (Raivisto).

VII. APPELLANT'S ARGUMENT

1. The inventions set forth in independent Claims 1 and 13 and their respective dependent Claims 2-6, 10-11 and 14-25 are not obvious within the meaning of 35 U.S.C. 103(a) over Zhang in view of Hiltunen. As the Board is no doubt aware, a determination of obviousness requires consideration of the invention considered as a whole; the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole. Furthermore, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention; a reference that teaches away from a claimed invention strongly indicates nonobviousness.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure.

Zhang discloses a mobile station monitoring system that has a maintenance task module to accumulate performance data reported within a mobile station, a transmission conduit for transmitting accumulated performance data to a central location, and a central receiver at the central location that receives and deciphers the transmitted accumulated performance data. Zhang also describes the mobile station as having a maintenance task module that accumulates the reported performance data within the mobile station. (Abstract). Zhang does not teach or suggest collecting data on a SIM card on at least one of the individual components and procedures embedded within a mobile station based on status quo information.

Although the Examiner's Office Action dated November 13, 2006, is not a model of clarity, Appellant will attempt to address the points as best understood. For example, while stating that Zhang does not describe or disclose a SIM card, the Examiner writes, at the bottom of page 3, "[i]n the same field of endeavor, Raivisto et al disclose [sic] on a subscriber information module (SIM) card ([0033])." Raivisto was relied on by the Examiner in rejecting the instant claims before prosecution was reopening and the Appellant believes the foregoing statement was inadvertently included in the November 13, 2006 Final Rejection when prosecution was reopened. On page 4 of the Examiner's Final Rejection, dated November 13, 2006, the Examiner writes "... in would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of Zhang by specifically including on a subscriber information module (SIM) card, as

taught by ...” Hiltunen. Because the remaining portion of the November 13, 2006, Final Rejection of Claims 1-6 and 10-25 is based on Zhang in view of Hiltunen, Appellant’s remarks regarding Claims 1-6 and 10-25 will be addressed to a rejection based on Zhang in view of Hiltunen.

To overcome the failure of Zhang to teach or suggest collecting data on a SIM card on at least one of the individual components and procedures embedded within a mobile station based on status quo information, we need to look to Hiltunen for such a teaching that would motivate a person skilled in pertinent art to arrive at Petitioner’s claimed invention. Petitioner’s effort is complicated because the Examiner did not follow the customary practice of indicating the pertinent portion of Hiltunen relied on to overcome the shortcoming of Zhang; thus, requiring Petitioner to parse Hiltunen to divine the Examiner’s analysis.

Hiltunen discloses the provisioning of services to and execution of services at a mobile terminal. The services may be locally, remotely or manually provisioned within the mobile terminal and may be viewed by a user of the mobile terminal. The services are accessible from a service panel on the mobile terminal, whereby a user selection of the service allows execution of the service at the mobile terminal using the appropriate underlying communication technology with no further interaction required from the user. (Abstract). Hiltunen describes services made available and provided to the mobile terminal such as weather information, music services, location information, news services, etc. (Para. 0036). That is, Hiltunen addresses the efficient recovery of inbound services to a mobile terminal by a user. Hiltunen describes a static provisioning mechanism for configuring a mobile terminal through the use of a SIM card or other removable memory card. (Para. 0048). Although Hiltunen mentions the use of a SIM card as a static provisioning mechanism to provide externally available services to a mobile terminal user, Hiltunen does not teach or suggest

that a SIM card can be provisioned or programmed with a routine for collecting data on at least one individual component or procedure embedded within a mobile communication apparatus based on status quo information. The Appellant notes that the inquiry is not whether each element exists in the prior art in order to support a rejection under 35 U.S.C. §103(a), but whether the prior art of Zhang and Hiltunen made obvious the invention as a whole. The Appellant submits there is no suggestion or teaching in Zhang and Hiltunen, taken together, that would motivate one of ordinary skill in the art to arrive at the claimed invention, much less enable the present invention. Thus, Zhang, individually or in combination with Raivisto, fails to teach or suggest the invention recited in independent Claims 1 and 13.

Although prosecution of this case was reopened based on a new reference, Petitioner would like to address certain comments in the June 30, 2006 Advisory Action which may still be relevant. The Examiner had previously stated that Zhang does not describe or disclose a method or apparatus for ascertaining the state of a mobile communication apparatus by using a SIM card, but took an apparent inconsistent position in the Advisory Action by stating, without stating why, he does not agree with it. (Advisory Action, page 2, paragraph 1). The Examiner also states that "... one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Advisory Action, page 2, paragraph 1). The Appellant respectfully calls the Board's attention to the fact that neither the Zhang nor the Hiltunen reference is being "attacked" individually, but that they are only being "attacked" in combination with each other. The Hiltunen reference provided by the Examiner is "attacked" herein only in its attempt to overcome the shortfall of Zhang. It was and continues to be Appellant's position that neither reference teaches or suggests a method or apparatus for ascertaining the state of a mobile communication apparatus by

using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile communication apparatus.

In the November 13, 2006, Final Rejection, the Examiner states that the motivation to combine Zhang and Hiltunen was "...in order to store data such as the content provided by a service provider, so the content is not lost upon power down of the mobile terminal." The Examiner also stated an additional reason of "..., it provides a simple and quick procedure which eliminates unnecessary wear and tear on a SIM." The first of these two reasons is not a motivation for ascertaining the state of a mobile communications apparatus by using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile communications apparatus. Neither the prior art nor Appellant's application address any need to store data so that it would not be lost on power down. This problem, if it is one, is simply not addressed. The second reason set forth by the Examiner is also not a valid motivation. The use of the SIM card must first be suggested before a person skilled in the pertinent art would even need to worry about eliminating unnecessary wear and tear on the SIM card. Neither reason provided by the Examiner provides motivation why a person skilled in the pertinent art should consider the use of a SIM card to ascertain the state of a mobile communication apparatus by collecting data on at least one of the individual components and procedures embedded within the apparatus. Not only are all of the elements of the present invention not provided for in the cited references, but there is no suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention by combining the two references.

There is no suggestion or teaching in Zhang, in view of Hiltunen, to collect data on a SIM card on at least one of the individual components and procedures embedded within a mobile station

based on status quo information. Therefore, independent Claims 1 and 13, as rejected by the Examiner, are not obvious under 35 U.S.C. §103(a) over Zhang in view of Hiltunen. Because Claims 2-6, 10-12 and 14-25 are each respectively dependent upon either independent Claim 1 or 13, they are also not obvious under 35 U.S.C. §103(a) over Zhang in view of Hiltunen.

2. Claims 7-9, as rejected by the Examiner, are not obvious under 35 U.S.C. §103(a) over Zhang in view of Hiltunen, and further in view of Ravisto. Claims 7-9 are each dependent on independent Claim 1. For the reasons set forth above, independent Claim 1 is not obvious over Zhang in view of Hiltunen. Ravisto does not overcome the shortcoming of either of Zhang and Hiltunen in this respect so as to render Claim 1 obvious. Therefore, dependent Claims 7-9 are not obvious over Zhand in view of Hiltunen, and further in view of Ravisto.

Raivistio is entitled “Apparatus and Method for Accessing Services Via a Mobile Terminal” and is “...directed to a system, apparatus, and method for locating available information and services/applications via mobile terminals through the use of a service panel that is operable via the mobile terminal.” (Para. 0009). Raivistio is similar to Hiltunen in that it describes a system for facilitating the provisioning of services and the execution of those services at mobile terminals and not to a method or apparatus for ascertaining the state of a mobile communication apparatus by using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile terminal.

Raivistio, like Hiltunen, is not directed to the problem of identifying, gathering data on and providing solutions for problems inherent in mobile phones. It is doubtful whether Raivistio, Hiltunen and Zhang are even in the same field of endeavor within the meaning of 35 U.S.C. 103(a)..

The main reason Appellant believes they may not even be in the same field of endeavor is because they represent extremely different aspects of mobile phone technology, which is a very broad field.

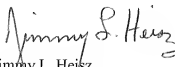
Zhang addresses the identification of mobile phone problems, gathering data regarding the same and providing solutions to such problems. On the other hand, Raivisto addresses how a user of a mobile phone can use that device to gather data from the communications network. Similarly, Hiltunen addresses how a user of a mobile phone may more efficiently access externally provided services. Reiterating, Zhang is concerned with the gathering of information about a mobile phone and delivering that information to the network; Raivisto addresses the providing of information to a user of a mobile phone about a network, after such information has been gathered; and Hiltunen addresses how a user can more efficiently access such information.

It should also be noted that, although Raivisto mentions that a SIM card is used to collect data, the data collected does not address the state of the mobile communication apparatus using the SIM card. Raivisto contains neither teaching or suggestion that a SIM card can be provisioned or programmed with a routine for collecting data on at least one individual component or procedure embedded within a mobile communication apparatus based on status quo information. The Appellant again notes that the inquiry is not whether each element exists in the prior art in order to support a rejection under 35 U.S.C. §103(a), but whether the prior art made obvious the invention as a whole. The Appellant submits there is no suggestion or teaching in Zhang, Hiltunen and Raivisto, individually or taken together, that would motivate one of ordinary skill in the art to arrive at the claimed invention, much less enable the present invention. Thus, Zhang, in view of Hiltunen and further in view of Raivisto, fails to teach or suggest the invention recited in dependent Claims 7-9.

For the reasons set forth above, the claims on appeal are not obvious. Zhang, individually or in combination with Hiltunen or in combination with both Hiltunen and Ravisto, fails to teach or suggest the invention recited in independent Claims 1 and 13. Because Claims 2-12 are ultimately dependent upon Claim 1 and Claims 14-25 are ultimately dependent on Claim 13, Zhang also does not render obvious Claims 2-12 and 14-25. Claims 1-25 are therefore not obvious under 35 U.S.C. §103(a). Accordingly, the Appellant respectfully requests that the Board of Patent Appeals and Interferences to reverse the Examiner's Final Rejection of all of the Appellant's pending claims.

Respectfully submitted,

HITT GAINES, P.C.


Jimmy L. Heisz
Registration No. 38,914

Dated: January 18, 2007

Hitt Gaines, P.C.
P.O. Box 832570
Richardson, Texas 75083-2570
(972) 480-8800
(972) 480-8865 (Fax)
Jimmy.heisz@hittgaines.com

VIII. APPENDIX A - CLAIMS

1. A method of ascertaining a state of a mobile communication apparatus, comprising:
collecting data on at least one of individual components and procedures embedded within said mobile communication apparatus, based on status quo information derived therefrom, on a subscriber information module (SIM) card; and
radio transmitting said data from said mobile communication apparatus via said radio network to which said mobile communication apparatus is affiliated to a service center.
2. The method as recited in Claim 1 wherein said collecting is performed by using a trace routine.
3. The method as recited in Claim 1 wherein said transmitting is performed by using a selected one of an SMS and a predefined data call.
4. The method as recited in Claim 1 wherein said data are coded in a space-efficient format prior to performing said radio transmitting.
5. The method as recited in Claim 1 wherein said data are stored prior to performing said radio transmitting.
6. The method as recited in Claim 1 wherein said radio transmitting is performed in regularly spaced intervals.
7. The method as recited in Claim 1 wherein said radio transmitting is performed during an initializing menu procedure.

8. The method as recited in Claim 7 wherein said menu procedure is activated during a selected one of when said mobile communication apparatus is logged-in to said network and when said mobile communication apparatus is logged-off from said network.

9. The method as recited in Claim 7 wherein said menu procedure is activated by a selected one of said user of said mobile communication apparatus and externally via said network.

10. The method as recited in Claim 1 wherein said data are transferred between said mobile communication apparatus and said network without signaling said user of said mobile communication apparatus.

11. The method as recited in Claim 1 wherein said data are weighted.

12. The method as recited in Claim 1 wherein a selected one of said collecting and said transmitting is carried out dependent on selectable information items.

13. A mobile communication apparatus, comprising:

a subscriber information module (SIM) card for use in said mobile communication apparatus, said SIM card having a means for collecting data on at least one of individual components and procedures embedded within said mobile communication apparatus based on status quo information derived therefrom; and

means for radio transmitting said data from said mobile communication apparatus via said radio network to which said mobile communication apparatus is affiliated to a service center.

14. The mobile communication apparatus as recited in Claim 13 wherein said means for collecting is a trace routine.

15. The mobile communication apparatus as recited in Claim 13 wherein said means for transmitting is a selected one of an SMS and a predefined data call.

16. The mobile communication apparatus as recited in Claim 13 wherein said data are coded in a space-efficient format prior to said radio transmitting.

17. The mobile communication apparatus as recited in Claim 13 wherein said data are stored prior to said radio transmitting.

18. The mobile communication apparatus as recited in Claim 13 wherein said radio transmitting is performed in regularly spaced intervals.

19. The mobile communication apparatus as recited in Claim 13 wherein said radio transmitting is performed during an initializing menu procedure.

20. The mobile communication apparatus as recited in Claim 19 wherein said menu procedure is activated during a selected one of when said mobile communication apparatus is logged-in to said network and when said mobile communication apparatus is logged-off from said network.

21. The mobile communication apparatus as recited in Claim 19 wherein said menu procedure is activated by a selected one of said user of said mobile communication apparatus and

externally via said network.

22. The mobile communication apparatus as recited in Claim 13 wherein said data are transferred between said mobile communication apparatus and said network without signaling said user of said mobile communication apparatus.

23. The mobile communication apparatus as recited in Claim 13 wherein said data are weighted.

24. The mobile communication apparatus as recited in Claim 13 wherein a selected one of said collecting and said transmitting is carried out dependent on selectable information items.

25. The mobile communication apparatus as recited in Claim 13 wherein said mobile communication apparatus is a mobile phone adapted to operate on a selected one of a GSM standard and a UMTS-standard.

IX. APPENDIX B - EVIDENCE

The evidence in this appendix includes the following, each of which was entered in the record by the Examiner with the March 13, 2006, Examiner' Office Action:

1. U.S. Patent Application Publication No. 20010029263 by Xiang Zhang.
2. U.S. Patent Application Publication No. 20040042604 by Miska Hiltunen, *et al.*
3. U.S. Patent Application Publication No. 20040075675 by Tommi Raivisto, *et al.*

X. RELATED PROCEEDINGS APPENDIX

NONE